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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/529,567	03/28/2005	Michael Primavera	2864 (203-3484)	9155
50855 7590 01/27/2009 Tyco Healthcare Group LP 60 MIDDLETOWN AVENUE NORTH HAVEN, CT 06473				
EXAMINER				
DANG, PHONG SON H				
ART UNIT		PAPER NUMBER		
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/529,567

Applicant(s)

PRIMAVERA ET AL.

Examiner

SON DANG

Art Unit

3773

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 05 November 2008.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-22 is/are pending in the application.
- 4a) Of the above claim(s) 17-21 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-16 and 22 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 05 November 2008 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO/55/06)
Paper No(s)/Mail Date 04/28/2005, 10/27/2006
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

1. The Amendment filed 11/05/2008 has been entered. Claims 1-16 and 22 remain pending in the application. The previous 35 USC 112 rejection of claim 14 is withdrawn in light of Applicant's amendments to claim 14. The previous objection to the drawing of figures 2-3 is also withdrawn in light of Applicant's submission of new drawings sheets of figures 2-3.

Claim Rejections - 35 USC § 103

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claims 1-10, 14-16 and 22 are rejected under 35 U.S.C. 103(a) as being unpatentable over US Patent No. 5,478,344 to Stone et al. (Stone) in view of US Patent No. 5,665,093 to Atkins et al. (Atkins).

In Reference to Claim 1:

Stone teaches:

A surgical instrument for manipulating a needle and suture comprising:

An elongate member (3 Fig. 1, Col. 3, line 37) having a distal end configured to manipulate a needle and suture (Fig. 1); a predetermined point on the elongate member (at the pivot joint for the jaws).

Stone fails to teach:

A scale on at least a part of the elongate member and extending from the distal end, the scale having at least one graduation configured and dimensioned to measure a distance between an end of the suture and the needle; and a predetermined point on the elongate member, wherein the scale indicates the distance from the predetermined point to the at least one graduation.

Atkins teaches:

A scale (60, Fig. 9, Col. 2, lines 1-3, Col. 4, lines 7-10) on at least a part of the elongate member (22, Fig. 9, Col. 3, line 25) and extending from the distal end, the scale (60, Fig. 9, Col. 2, lines 1-3, Col. 4, lines 7-10) having at least one graduation (Fig. 9); and a predetermined point (34, Fig. 9, Col. 3, lines 35) on the elongate member (22, Fig. 9, Col. 3, line 25) , wherein the scale (60, Fig. 9, Col. 2, lines 1-3, Col. 4, lines 7-10) indicates the distance from the predetermined point to the at least one graduation (Fig. 9).

It would have been obvious to one having ordinary skill in the art at the time of the invention to have combined the teaching of Atkins with Stone to produce a device having a scale with graduation on its tubular body for measuring purposes to facilitate surgery (see Atkins, Col. 4, lines 7-10).

In Reference to Claim 2:

Stone as modified by Atkins teaches:

The surgical instrument as recited in claim 1 (see rejection of Claim 1 above), wherein the elongate member (3 Fig. 1, Col. 3, line 37) includes at least

one jaw (5, Fig. 1) and the predetermined point (15, Fig. 1, Col. 3, lines 53-54) is disposed on the jaw.

In Reference to Claim 3:

Stone as modified by Atkins teaches:

The surgical instrument as recited in claim 2 (see rejection of Claim 2 above), wherein the at least one jaw (5, Fig. 1) has a recess (15, Fig. 1, Col. 3, lines 53-54) configured to retain a needle carrying a suture and the predetermined point is located on the needle (Fig. 7, where the suture 18 goes into needle 14).

In Reference to Claim 4:

Stone as modified by Atkins teaches:

The surgical instrument as recited in claim 2 (see rejection of Claim 2 above), wherein the at least one jaw (5, Fig. 1) has a recess configured to retain a needle carrying a suture (15, Fig. 1, Col. 3, lines 53-54), and the predetermined point is located at a point of connection between the suture and the needle (66, Fig. 8).

In Reference to Claim 5:

Stone as modified by Atkins teaches:

The surgical instrument as recited in claim 4 (see rejection of Claim 4 above), wherein the point of connection is at one end (66, Fig. 8, Col. 5, lines 4-5) of the needle.

In Reference to Claim 6:

Stone as modified by Atkins teaches:

The surgical instrument as recited in claim 4 (see rejection of Claim 4 above), wherein the point of connection is located between (66, Fig. 8) the ends of the needle.

In Reference to Claim 7:

Stone as modified by Atkins teaches:

The surgical instrument as recited in claim 2 (see rejection of Claim 2 above), wherein the at least one jaw (5, Fig. 1) is movable relative to the elongate member (3, Fig. 1), wherein the distance from the predetermined point (66, Fig. 8) and the scale is calibrated with the at least one movable jaw (5, Fig. 1) in a predetermined position. (After putting the scale from Atkins on the tubular member (3, Fig. 1) of Stone, you would consequently have the predetermined position in at least one movable jaw).

In Reference to Claim 8:

Stone as modified by Atkins teaches:

The surgical instrument as recited in claim 7 (see rejection of Claim 7 above), wherein elongate member includes two movable jaws (4, 5, Fig. 1).

In Reference to Claim 9:

Stone as modified by Atkins teaches:

The surgical instrument as recited in claim 8 (see rejection of Claim 8 above), wherein the two movable jaws (4, 5, Fig. 10) are configured to pass a needle carrying a suture there between.

In Reference to Claim 10:

Stone as modified by Atkins teaches:

The surgical instrument as recited in claim 1 (see rejection of Claim 1 above), wherein the scale includes a plurality of graduations (Fig. 9 from Atkins).

In Reference to Claim 14:

Stone as modified by Atkins teaches:

The surgical instrument as recited in claim 1 (see rejection of Claim 1 above), wherein the scale is etched (Atkins, Col. 2, lines 1-3) into the elongate member.

In Reference to Claim 15:

Stone as modified by Atkins teaches:

The surgical instrument as recited in claim 1 (see rejection of Claim 15 above), wherein the at least one graduation indicates the distance in centimeters (Col. 2, lines 1-3).

In Reference to Claim 16:

Stone as modified by Atkins teaches:

The surgical instrument as recited in claim 1 (see rejection of Claim 1 above), wherein the at least one jaw (4, Fig. 1) is configured for grasping a needle carrying a suture.

In Reference to Claim 22:

Stone teaches:

In a surgical suturing apparatus including an elongate member (3, Fig. 1) having a proximal end and a distal end and a longitudinal axis; a pair of jaws (4,

5, Fig. 1) at the distal end, at least one of the pair of jaws being movable (Fig. 1), the pair of jaws (4, 5, Fig. 1) each having a recess (15, Fig. 9, Col. 3, lines 53-54) for receiving a suture carrying needle; needle retaining structure (15, Fig. 9) in each jaw of the pair of jaws, the needle retaining structure extending from the respective jaw toward the proximal end (Fig. 9); and a handle (2, Fig. 1, Col. 3, lines 28) at the proximal end including structure for alternately advancing and retracting the needle retaining structure the improvement (Col. 4, lines 38-60).

Stone fails to teach:

A scale defined on the elongate member, the scale extending along the longitudinal axis of the elongate member and having graduations configured and dimensioned to measure a distance between an end of the suture and the needle.

Atkins teaches:

A scale (60, Fig. 9, Col. 2, lines 1-3, Col. 4, lines 7-10) defined on the elongate member (22, Fig. 9, Col. 3, line 25), the scale (60, Fig. 9, Col. 2, lines 1-3, Col. 4, lines 7-10) extending along the longitudinal axis of the elongate member (22, Fig. 9, Col. 3, line 25) and having graduations (Fig. 9) for measuring the length of the suture.

It would have been obvious to one having ordinary skill in the art at the time of the invention to have combined the teaching of Akins with Stone to produce a device having a scale with graduation on its tubular body for the same reasons as noted in claim 1 above.

9. Claims 11-13 are rejected under 35 U.S.C. 103(a) as being unpatentable over Stone in view of Atkins as applied to claim 1 and further in view of US Patent No. 5,237,985 to Hodgson et al. (Hodgson).

In Reference to Claim 11:

Stone as modified by Atkins teaches:

The surgical instrument as recited in claim 1 (see rejection of Claim 1 above).

Stone as modified by Atkins fails to teach:

The instrument having a scale provided on a material affixed to the elongate member.

Hodgson teaches:

The instrument having a scale (Fig. 12, Col. 10, lines 29-35) provided on a material affixed to the elongate member (shrink warp scale 184 on Fig. 12).

It would have been obvious to one having ordinary skill in the art at the time of the invention to have substituted the shrink wrapped scale of Hodgson in place of the scale of Stone as modified by Atkins because such a modification would have been considered a mere substitution of art-recognized scales.

In Reference to Claim 12:

Stone as modified by Atkins and Hodgson teaches:

The surgical instrument as recited in claim 1 (see rejection of Claim 1 above), wherein the scale is located on shrink wrap affixed to the elongate member (184, Fig. 12, Col. 10, lines 29-35).

In Reference to Claim 13:

Stone as modified by Atkins and Hodgson teaches:

The surgical instrument as recited in claim 11 (see rejection of Claim 11 above), wherein the scale is located on at least one longitudinally extending strip of material (Fig. 12, Col. 10, lines 29-35).

Response to Arguments

Applicant's arguments filed 11/05/2008 have been fully considered but they are not persuasive. In regard to claims 1-10, 14-16 and 22, the applicant argues on pages 9-10 of the Remarks that the cited references do not teach the same intended use as the applicant's invention did. This argument is not persuasive because whether or not the scale as indicated in the reference is using to measure the depth of the insert instrument or is using to measure a length of a suture material, the scale is still a measuring device. In regard to claims 11-13, the applicant argues on pages 10-11 of the Remarks that the cited references do not solve the same problem as cited in the applicant's invention. The argument is also not persuasive because whether or not the instructional indicia in the cited reference is using for indication of the volume necessary to fully inflate the balloon or is using for any other measuring purposes, it is still a measuring device using to measure. Per reasonable interpretation of the actual claimed language, the cited references remain obvious to the claimed invention as indicated in the above paragraphs.

Conclusion

4. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to SON DANG whose telephone number is (571)270-5809. The examiner can normally be reached on Monday-Friday 7:30 AM - 5:00 PM EDT.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jackie Ho can be reached on 571-272-4696. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

SD
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